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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,554	08/12/2003	Teresa S. Healy	GRAY033/00US	5392

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COOLEY GODWARD LLP  
ATTN: PATENT GROUP  
11951 FREEDOM DRIVE, SUITE 1700  
ONE FREEDOM SQUARE- RESTON TOWN CENTER  
RESTON, VA 20190-5061

EXAMINER

MORAN, KATHERINE M

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/638,554	<b>Applicant(s)</b> HEALY ET AL.	
	<b>Examiner</b> Katherine Moran	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>44-17-05 11-14-05 km</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment of 11/14/05 has been received and reviewed. Applicant amended claims 1, 11, and 28 and submitted an IDS. Upon further consideration, the indicated allowable subject matter of the previous office action has been withdrawn.

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 11/14/05 was filed after the mailing date of the application submission on 8/12/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the membrane coupled to the inner member of the cover (claim 8) and membrane coupled between the inner member of the cover and the outer member of the cover (claim 9) must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The applied reference has a common inventor and/or assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed

subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

4. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeGette et al. (LeGette, U.S. 6,332,223) in view of Felman (U.S. 6,065,157). LeGette discloses the invention substantially as claimed. LeGette teaches an ear warmer comprising a cover 200, an outer member 130 and an inner member in the form of first ear portion 100, second ear portion 110, and a middle portion 120 extending between the first and second ear portions. The outer and inner members define an interior region therebetween, and a frame 300 configured to extend around a back of a user's head, with at least a portion of the frame being disposed in the interior region defined by the outer and inner members. Regarding claim 16, the frame inherently applies a compression force to the wearer's head when worn, due to the frame's frusto-conical shape, and the membrane inherently applies a friction force against the wearer's head as well as the frame, to secure the ear warmer to the wearer's head. With regard to claim 20, the frame has a deployed configuration and a collapsed configuration in that the frame as recited in column 4, lines 5-17 teach a slidably adjustable band 320 such

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that the frame takes on a deployed and collapsed configuration depending on how the band is adjusted. Given that the membrane is attached to the frame, the membrane takes on the configuration of the frame. The method steps of claims 28 and 29 are inherent in the device taught by LeGette. Frame 300 is configured to extend around a back of a head of the user. However, LeGette doesn't teach a membrane coupled to the cover, with the membrane and inner member of the cover forming a receptacle configured to receive at least a portion of an ear of a user between the membrane and the cover. LeGette also doesn't teach the membrane has a movable portion and a fixed portion, and a deployed and retracted configuration, with the membrane coupled to a portion of one of the first and second ear portions along a perimeter of the ear portion using a binding, the portion of the perimeter being less than the entire perimeter of the ear portion. Felman teaches an ear warmer 14,16 with first and second membranes 34,36 coupled to the cover portion 30,32, with the first and second membranes and inner sides of the covers forming a receptacle configured to receive at least a portion of user's ears between the respective membrane and the cover. Felman teaches that the membrane is sewn or binded to the cover, forming a fixed portion at 38,40 and a movable portion at the open end of the membrane. This configuration allows for the membrane to be manipulated in a deployed configuration and a retracted configuration, with the movable portion of the membrane disposed adjacent the inner side when the membrane is in its deployed configuration and at least a portion of the movable portion of the membrane disposed adjacent the outer member when the membrane is in its retracted configuration. The cover has an ear portion with a perimeter, with the

membrane coupled to the ear portion along a portion of the perimeter of the ear portion and the portion of the perimeter is less than the entire perimeter of the ear portion.

Regarding claims 8 and 9, the membrane could be coupled to the inner cover member or disposed between the inner and outer cover members as desired. Applicant's specification does not disclose unexpected results from disposing the membrane in a particular position and on pg. 10, lines 4-7 recites the different configurations as being equivalent. Accordingly, the membrane could have been placed in any desired relationship with the cover members as preferred. Therefore, it would have been obvious to couple the membrane to the inner cover or between the inner and outer cover members, to prevent unsightly seams.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (703) 872-9306. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Kmm

January 19, 2006

A handwritten signature in black ink, appearing to read "K Moran", with a long horizontal flourish extending to the right.

Katherine Moran

Primary Examiner, AU 3765